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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,968	07/30/2001	Hatem Oueslati	PALM-3686	2575

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EXAMINER

EISEN, ALEXANDER

ART UNIT	PAPER NUMBER
2674	6

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,968

Applicant(s)

OUESLATI ET AL.

Examiner

Alexander Eisen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-28 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,12,13,17 and 18 is/are rejected.
- 7) ☒ Claim(s) 8-10 and 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in alternative, under 35 U.S.C. 103(a) as being obvious over Morgenthaler, US 6,310,609 (reference of record).

With respect to claim 1 Morgenthaler discloses a user interface for portable electronic device including a keyboard having illuminated keys and a plurality of functions associated with each of the plurality of keys (note the indicia on the keys) for providing a user with guide functions (see abstract, FIGS. 1, 4 and 5; col. 5, line 42 – col. 6, line 60), wherein in response to execution of a function (occurrence of an event), the next key will be selectively illuminated providing therefore information regarding the event (col. 7, ll. 13-24).

As to claim 2, Morgenthaler's buttons have contoured regions in a shape of symbols, which functions they represent.

As to claim 4, the illuminatable keys are controlled by a microcontroller executing a program, i.e. under software control (see flowchart in FIG. 4; col. 8, lines 54-58), and therefore is programmable.

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3. Claims 5, 6, 7, 12-13, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgenthaler in view of Muurinen, US 5,408,060, reference of record.

In regards to claims 6 and 7 Morgenthaler discloses a user interface for portable electronic device and method of using the same including providing a hard button operable to perform a primary function, the button provided with a contoured region in a shape of a symbol that represents the primary function; providing at least one light source for backlighting the button; and selectively illuminating the button to communicate information to a user regarding and in response to the occurrence of a particular event that is associated with the hard button, wherein selectively illuminating the hard button provides information regarding the event (if the event will necessitate the next button to be pressed in a chain of commands necessary to accomplish certain function) and further to indicate that the hard button may be pressed to perform a function (associated with that button; col. 7, ll. 13-24).

Even though Morgenthaler discloses various types of illuminatable hard buttons (col. 2, lines 36-47; col. 8, lines 27-36) it does not specifically disclose that the light from the illuminated light source is emitted through the contoured region representing a function to illuminate the hard button.

Muurinen teaches an illuminatable button, wherein information about the button current functions is conveyed to a user by providing a light of different colors through a contoured region on the top of the button, the region formed in the shape of a symbol that represent a primary function that is performed, when the button is pressed (see FIGS. 1-6, 12; col. 2, line 57 – col. 3, line 11).

It would have been obvious to one of ordinary skill in the art at the time when the invention was made to employ Muurinen's teachings in the keyboard of Morgenthaler, because it complements Morgenthaler with yet another type of lighting a button in addition, and as an alternative, to those disclosed by Morgenthaler, without bringing about any unexpected result.

As to claim 5, Muurinen teaches using different colors to represent different functions of a button (col. 4, lines 20-42).

As to claims 12-13, Morgenthaler further teaches, that in order to provide the user with additional information, an indexing key (up and down key 342) is equipped with two light sources, which are only illuminated when the user can scroll up or down (see col. 6, line 60 – col. 7, line 3).

As to claims 17 and 18, Morgenthaler teaches programmable buttons, such as a soft key 228, function of which is reprogrammed according to a menu changing displayed on a display, and this button is selectively illuminated to indicate function that should be taken by a user (col. 5, ll. 19-34).

Allowable Subject Matter

4. Claims 8-11 and 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: there was no prior art found by the examiner that suggested modification of or combination with the cited prior art so as to satisfy the limitations of dependent claims 8-11.

6. Claims 19-28 are allowed.

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7. The following is an examiner's statement of reasons for allowance: applicant's arguments in regards to independent claim 19 have been fully considered and found persuasive; none of the prior art, either singularly or in combination with the cited prior art, teach or fairly suggest the combination of the limitations of the independent claim 19.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

8. Applicant's arguments filed on 24 May 2004 have been fully considered and answered by the examiner in the rejections of claims 1, 2, 4-7, 12-13 and 17-18, whereby the old reference has been applied with new examiner's interpretation (new grounds of rejection). The persuasiveness of the arguments related to claims 8-11, 14-16 and 19-28 resulted in allowance of these claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (703) 306-2988. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on (703) 305-4709. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Eisen
Primary Examiner
Art Unit 2674

2-Aug-04